

REMARKS

STATUS OF THE CLAIMS

In accordance with the foregoing, claim 3 has been cancelled and claims 1, 2 and 4-14 have been amended. Claims 15, 16 and 17 have been added.

It is respectfully submitted that claims 1, 2 and 4-17 are pending and under consideration. No new matter is being presented, and approval and entry of the amended and new claims are respectfully requested.

I. REJECTION OF CLAIMS 1-14 FOR OBVIOUSNESS UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER KRISHNAN ET AL. (U.S. PATENT NO. 6,073,124) IN VIEW OF MIHM, JR. (U.S. PATENT NO. 5,249,230):

The rejections of claims 1-14 are respectfully traversed and reconsideration is requested.

Krishnan et al. (hereinafter "Krishnan") teaches a method and system for facilitating the purchase and delivery of electronic content using a secure digital commerce system. (See column 4, lines 10-20). In Krishnan, an electronic license certificate is generated from tables stored in a password data repository. Each table contains license parameters, and each license is generated specifically for a particular item and for a specific customer request. Once a valid license certificate for the requested merchandise is received, the merchandise is made available to the customer for use in accordance with the license parameters. (See column 4, lines 45-55).

Krishnan discloses the ability to generate an emergency electronic license certificate in cases where a license certificate would not normally be authorized. In order to generate an emergency license, a separate emergency password generation table is accessed. (See column 4, lines 55-65).

Mihm, Jr. (hereinafter "Mihm") discloses a method and system for insuring that services are provide only to legitimate users of the services. (See column 1, lines 5-10). According to Mihm, "subscribers may pay extra for a high priority service which will be more readily available in times of heavy communication traffic." Governmental emergency services also may be awarded high priority user IDs. (See column 7, lines 1-8).

In contrast, the present application discloses a method and apparatus for administering user rights that can expand a volume license of a software program through a computer network, and can detect the occurrence of at least a predetermined event, the occurrence of which allows the user rights of the software program to be expanded, as recited in amended

claim 1. As described on page 14, lines 25-30 of the Specification, the trigger processing unit 132 determines whether any event stipulated in the volume licensing agreement has occurred and informs the notice output processing unit 131 of the occurrence. (See also FIGS. 6, 7 and 8).

Neither Krishnan nor Mihm teaches or suggests this limitation and, thus, it is respectfully submitted that claim 1 is not obvious from the references to one of ordinary skill in the art. Claims 2 and 4 depend from amended claim 1 and include all of the patentable limitations thereof. Therefore, claims 2 and 4 inherit the patentability of claim 1.

Amended claims 6, 8, 9, 12 and 13 include similar patentable recitations and, therefore, the arguments above for amended claim 1 are asserted therefor. Thus, it is respectfully submitted that claims 6, 8, 9, 12 and 13 are not obvious from the references.

The present application also includes the ability to receive a notice indicating the occurrence of at least the predetermined event, as recited in amended claims 5, 7, 10, 11 and 14. Krishnan and Mihm do not teach or suggest this limitation. Therefore, it is respectfully submitted that claims 5, 7, 10, 11 and 14 are patentable over the references.

According to MPEP 2143, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations."

Furthermore, the mere fact that the references can be combined does not render the combination obvious, unless the prior art suggests the desirability of the combination. (See MPEP 2143.01 and *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In rejecting claims 1 and 6-14, the Examiner refers to Krishnan in view of Mihm. However, the Examiner has not shown that there is any suggestion or motivation to combine the teachings of these references. Therefore, the Examiner has not demonstrated a *prima facie* case of obviousness.

II. NEW INDEPENDENT CLAIMS 15, 16 and 17

New claim 15 discloses a computer readable recording medium storing a computer

program comprising instructions to receive a notice indicating the occurrence of at least a predetermined event. As argued above for claims 5, 7, 10, 11 and 14, Krishnan and Mihm do not teach or suggest this patentable limitation.

New claim 16 contains similar limitations as those of claim 15, including program instructions to receive a notice indicating the occurrence of at least a predetermined event. As argued above for new claim 15, Krishnan and Mihm do not teach this limitation.

New claim 17 is a method claim based on the limitations of claims 15 and 16. Claim 17 recites a method of administering a user right agreement of a software program, including receiving a notice indicating the occurrence of at least a predetermined event. As argued above, Krishnan and Mihm do not teach this limitation.

Therefore, claims 15, 16 and 17 patentably distinguish over the references, and entry and approval are respectfully requested.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome, and all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: May 17, 2005

By: 
H. J. Staas
Registration No. 22,010

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501